

REMARKS

REJECTION UNDER 35 U.S.C. § 101

The Examiner rejects claims 1-19 for purportedly being “directed to non-statutory subject matter.” *Office Action*, 4, ¶ 10. Specifically, the Examiner contends that the network appliance of claim 1 and the system of network appliances in claim 11 “comprises only software,” which “is not a physical article or object and as such is not a machine or manufacturer.” *Office Action*, 4, ¶ 11 (concerning claim 1); 5-6, ¶ 12 (concerning claim 11).

The Applicants have amended independent claims 1 and 11 as well as various intermediate dependent claims in light of the present rejection. In claims 1 and 11, the Applicants have included the recitation of memory for storage of, for example, a platform service; service monitor; and load balancer. The Applicants believe that the specification supports these amendments; as a result, no new matter is entered.

The specification notes that “the various features of the invention will be implemented by executing software instructions on a programmable computing device or computer [201].” *Specification*, 8, ¶ [26]. “The computer system 201 . . . includes a processing unit 203” and “system memory 205[, which] may include a read-only memory (ROM) 209 and a random access memory (RAM) 211.” *Specification*, 8, ¶ [27]. The system may alternatively embody:

a hard disk drive 215 for reading from and writing to a hard disk (not shown), a magnetic disk drive 217 for reading from or writing to a removable magnetic disk (not shown), or an optical disk drive 219 for reading from or writing to a removable optical disk (not shown) such as a CD-ROM or other optical media.

Specification, 9, ¶ [27]. Regardless of the particular implementation, the Applicants contend that more than adequate written description exists with respect to supporting the amendment to claims 1 and 11.

Through these amendments, the Applicants have met the Supreme Court's "definitive test to determine whether a process claim is tailored narrowly enough" to encompass statutory subject matter under Section 101. *In re Bilski*, No. 2007-1130, slip. op. at 10 (Fed. Cir. 2008). The Federal Circuit, in *Bilski*, characterized *Gottschalk v. Benson* as setting the bar for concluding that "[a] claimed process is surely eligible" if that process "is tied to a particular machine or apparatus." *Bilski*, slip op. at 10 (citing *Benson*, 409 U.S. 63, 67 (1972)). The recitation of memory for storage of the aforementioned services, monitors, and balancers in conjunction with (as appropriate) processing components constitute the requisite machine or apparatus called for by *Bilski* and *Benson*. As such, the Examiner's rejection is believed to have been overcome.

DRAWING OBJECTION

The Examiner contends that the drawings submitted February 18, 2008 fail to show "every feature of the invention specified in the claims." *Office Action*, 3, ¶ 8. The Applicants respectfully disagree and refer the Examiner to the provisions of 37 C.F.R. § 1.81 that state "[t]he applicant for a patent is required to furnish a drawing of his or her invention **where necessary for the understanding of the subject matter sought to be patented.**" 37 C.F.R. § 1.81(a) (emphasis added). The Applicants believe that it is not necessary to visually illustrate 'a working status indicating whether the at least one platform service is running' in order to understand the subject matter sought to be patented. The Applicants therefore respectfully request that the Examiner withdraw the drawing objection rendered pursuant to 37 C.F.R. § 1.83(a).

REJECTIONS UNDER 35 U.S.C. § 102(b)

The Examiner continues to assert that U.S. patent number 6,128,279 to O’Neil discloses ‘a working status indicating whether the at least one platform service is running.’ See *Office Action*, 2, ¶ 4-5. The Applicants initially presented this argument in the prior response. See *RCE/Amendment B*, 8. Notwithstanding, the Examiner continues to contend that ‘the working status’ is represented by “load, operating capacity, and whether the load exceeds the predetermined level.” *Office Action*, 2, ¶ 5; see also *Office Action*, 2, ¶ 6 (quoting O-Neil at col. 6, l. 17-33).

As presented in the Applicants’ arguments dated February 14, 2008, the specification of the present application (paragraph [60]) does not lend ‘working status’ of a platform service to refer to load or load processing. Rather, working status of a platform service may indicate whether the platform service is “RUNNING,” “NOT RUNNING,” or “STARTING.” Each of the independent claims have been further amended to explicitly recite the same (*i.e.*, ‘the working status **indicating that** the at least one platform service is **running, not running, or starting**’).

The Examiner also suggests that the load of O’Neil “is an indication of an amount of work that the server is currently processing”; “[a] server that is currently processing is a running server.” *Office Action*, 3, ¶ 7. The Applicants respectfully disagree with this argument in two respects. First, the independent claims all recite ‘the working status indicating . . .’ The working status affirmatively indicates a particular state; the Examiner improperly relies upon inherency to support its rejection. Second, and notwithstanding the first argument, the claims now read in the restrictive (*i.e.*, that) rather than the interrogative (*i.e.*, whether) and thus require proper interpretation with respect to the same.

As to the first point of distinction, the Examiner's rejection's relies upon a purported inherent or presumed characteristic related to load. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). "Inherency . . . may not be established by probabilities or possibilities. . . . [T]hat a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); see also MPEP § 2112(IV) (concerning burden of proof in an inherency rejection).

As to the second point concerning grammatical import, the restrictive nature of 'that' versus the interrogative meaning of 'whether' cannot be overlooked. In *Superguide Corporation v. DirecTV Enterprises, Inc.*, 358 F.3d 870 (Fed. Cir. 2004), the Federal Circuit addressed the specific issue of what claim terms a particular phase modified **as a matter of grammatical construct**. See *Superguide*, 358 F.3d at 885-87 (concerning the import of grammatical principles). The same grammatical principles that guided the court in *Superguide* are of equal import in the present case.

'That' is used for introducing a restrictive clause. 'Whether' is used to introduce an interrogative content clause that consists of alternative possibilities or uncertainties. If the claim recites 'the working status indicating **that** the at least one platform service is running, not running, or starting,' the working indicator **must** indicate such status. The indication is not accidental or tangential—it is affirmative and definite. Recitation of 'whether' (all the independent claims recite the restrictive **that**), however, allows for the indicator to perhaps make such an indication. There exist—through the recitation of whether—alternative possibilities (the indicator does or it does not). The claims do not recite 'whether' but 'that.'

The Examiner's inherency based rejection (aside from being legally improper) is more akin to a recitation of 'whether.' The independent claims do not, as noted, read in the interrogative or the alternative. The working status indicator must indicate the status as set forth in the claims. O'Neil fails to disclose this element and the rejection is thus overcome.

CONCLUSION

The Applicants believe that the present amendments overcome the Examiner's 35 U.S.C. § 101 rejection. All claims are believed to be directed toward statutory subject matter.

The Applicants do not believe that the Examiner's drawing objection is appropriate. Withdrawal of the drawing objection is respectfully requested.

The Applicants have again evidenced the failure of O'Neil to disclose all the elements of the independent claims 1, 11, and 20, specifically 'the working status indicating that the at least one platform service is running, not running, or starting.'

Any claim dependent upon one of the aforementioned independent claims—either directly or via an intermediate dependent claim—is allowable for at least the same reasons as the claim from which it depends. As such, each and every one of the dependent claims of the present application are also in condition for allowance.

The Applicants contend the present application is in condition for allowance. The Examiner is invited to contact the Applicants' undersigned representative with any questions.

Respectfully submitted,
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